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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,320	10/28/2003	Jerry J. Fielding JR.	4889-000001	4849
27572	7590	08/16/2004	EXAMINER	
HARNES, DICKEY & PIERCE, P.L.C. P.O. BOX 828 BLOOMFIELD HILLS, MI 48303			MILLER, BENA B	
			ART UNIT	PAPER NUMBER
			3712	

DATE MAILED: 08/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/695,320

Applicant(s)

FIELDING, JERRY J.

Examiner

Bena Miller

Art Unit

3712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-12 and 15-22 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,3-12 and 15-22 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 17-19 are finally rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 17, there is lack of antecedent basis for the limitation "the flat upper deck portion".

Regarding claims 18 and 19, it is not clear how the structural limitations of the claims further limit the claimed method.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 11, 15, 16 and 17-21 are finally rejected under 35 U.S.C. 102(b) as being anticipated by Zappitelli.

Zappitelli teaches in the figures a submersible water toy comprising a main body (12 and 14), an upper deck surface (10), the main body portion operable to support the user's weight (10) and the main body portion completely and unitarily formed of foam material (col. 5, par. 2).

Regarding claim 11, Zappitelli further teaches disk-shaped main body portion (fig.9).

Regarding claim 15, Zappitelli further teaches a substantially flat central portion (fig.1).

Regarding claim 16, Zappitelli further teaches the central portion having a length substantially greater than a width (The examiner takes the position that the central portion of Zappitelli has a length substantially greater than a width).

Regarding claim 17, Zappitelli teaches in the figures the method comprising the steps of providing (10), completely submersing (fig.7), positioning (fig.7) and supporting (fig.7).

Regarding claims 18 and 19, Zappitelli further teaches the step of positioning and standing (fig.7). It should be noted that the examiner considers the structure of the claims to be inherent in the method of Zappitelli.

Regarding claim 20, Zappitelli further teaches an uninterrupted upper surface (fig.1).

Regarding claim 21, Zappitelli further teaches in the figures a submersible water toy comprising an elongated foam core (12,14), an uninterrupted upper deck surface (fig.6), a length and a width (fig.6) and the elongated foam core having a main body portion with generally constant cross section in a direction perpendicular to the length (fig.6).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 3 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Zappitelli in view of Jang.

Zappitelli teaches in the figures most of the elements of the claimed invention except for expandable polystyrene foam. Jang teaches in the figures teaches a surfboard made of expandable polystyrene foam main body (col. 1, line 46. It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate expandable polystyrene foam as taught by Jang for the main body of Zappitelli for the purpose of preventing the main body from cracking or wearing off easily after long uses

Claim 4 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Zappitelli.

Zappitelli teaches in figures most of the elements of the claimed invention except for the main body portion constructed of ethylene vinyl acetate. It would have been considered a mere design choice to have the main body portion of Zappitelli to be constructed of ethylene vinyl acetate for the purpose of supporting the weight of the user.

Claims 5, 6 and 22 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Zappitelli in view of Seifert et al.

Zappitelli teaches most of the elements of the claimed invention except for front and rear ends which are angled upwardly. Seifert et al. teaches sports board having convex front and rear ends (17F and 17R; fig.1) thereon. It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate angled upwardly front and rear ends as taught by Seifert et al. on the main body of Zappitelli for the purpose of interacting with the surface over which the rider is riding.

Claim 7 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Zappitelli.

Zappitelli teaches in figures most of the elements of the claimed invention except for the main body portion having a length of approximately 31 inches, a width of approximately 8 inches and a thickness of approximately 2 inches. It would have been considered a mere design choice to have the main body portion of Zappitelli having a length of approximately 31 inches, a width of approximately 8 inches and a thickness of approximately 2 inches for the purpose of supporting the weight of the user.

Claim 8 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Zappitelli in view of Johnson III.

Zappitelli teaches in the figures most of the claimed elements except for a plastic shell substantially surrounding the foam core. Johnson III teaches in the figures a sports board having a plastic shell substantially surrounding the foam core (col. 3, lines 10-19). It would have been obvious to one having ordinary skill in the art at the time the

invention was made to surround the foam core of Zappitelli with a plastic shell as taught by Johnson III for the purpose of preventing wear and tear to the main body.

Claims 9 and 10 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Zappitelli.

Zappitelli teaches in the figures most of the elements of the claimed invention, including a buoyant panel (16). However, Zappitelli fails to teach a plurality of buoyant panels. It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a plurality of buoyant panels, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Claim 12 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Zappitelli in view of Milford.

Zappitelli teaches in the figures most of the elements of the claim invention except for concaved upper deck disk-shaped main body. Milford teaches a water toy in the figures having concave upper deck disk-shaped main body (10; fig.6). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a concaved upper deck disk-shape as taught by Milford for the main body of Zappitelli for the purpose of increasing user safety by eliminating sharp edges.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Moran.

Moran teaches in figures most of the elements of the claimed invention except for the buoyant panels are removably secured to the main body portion with elastic bands. It would have been considered a mere design choice to have the buoyant panels

removably secured to the main body of Moran for the purpose of supporting the weight of the user.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bena Miller whose telephone number is 703.305.0643. The examiner can normally be reached on Monday-Friday.

Art Unit: 3712

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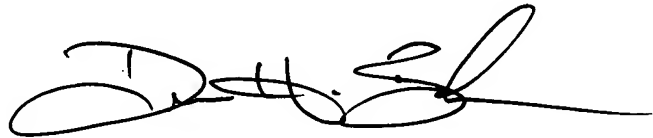
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you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

bbm
August 11, 2004

A handwritten signature in black ink, appearing to read 'D. H. Banks', with a long horizontal line extending to the right.

**DERRIS H. BANKS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700**